

**REMARKS:**

The Examiner noted that claims 14, 17, 20, 23 and 25 are pending in the application, and the Examiner rejected all claims. By this Amendment, claim 25 has been cancelled without prejudice or disclaimer, and claims 14, 17, 20, and 23 have been amended. Claims 1-13, 15, 16, 18, 19, 21, 22 and 24 remain cancelled. No new matter has been presented.

The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested. Thus, claims 14, 17, 20 and 23 are pending and under consideration.

**REJECTIONS UNDER 35 USC §103:**

In item 4 on page 2 of the Office Action the Examiner rejected claims 14, 17, 20, 23, and 25 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,684,195 (Deaton) in view of U.S. Patent No. 6,529,940 (Humble). By this Amendment, claim 24 has been cancelled without prejudice or disclaimer. The Applicants respectfully traverse the Examiner's rejections of the remaining claims.

The claimed invention "updates cumulative issued points, and decreases the cumulative issued points according to a time spent for providing the electronic information service which is redeemed by the customer's request with the cumulative issued points to a customer terminal", as recited for example in claim 14. Deaton and Humble do not teach or suggest at least this feature of the claimed invention.

Instead, Deaton only refers to effectiveness of incentive coupons if they are not redeemed within a selected time period. There is no teaching in Deaton that is directed to decreasing coupons by an amount which corresponds to a time during which a service is provided.

At least on page 2 of the outstanding Office Action, the Examiner alleges that Deaton teaches decreasing cumulative issued points in proportion to a time used for providing an information service according to the cumulative points. However, the portions of Deaton pointed out by the Examiner are limited to initial dispersment of incentive coupons (see, Fig.18C including corresponding text) and does not teach or suggest decreasing cumulative points. In fact, Deaton teaches away from a system that "decreases the cumulative issued points according to a time spent for providing the electronic information service", as taught by the claimed invention because decreasing value of the coupons in Deaton based on when the customer visits would make the system inoperable for its intended purpose of encouraging

customers to visit a store.

Independent claims 17, 20 and 23 recite similar features as claim 14 and are thus distinguishable over Deaton.

The claimed redeeming of points according to "a time spent for providing the electronic information service" causes the cumulative issued points to be decreased by the exact time during which the user has spent benefiting from the electronic information service. This enables a user to be charged by actual use, for example, stopping the points from being decreased in a case when the user decides to stop being provided with the electronic information such that the cumulative issued points are not decreased for the (partial) service from which the user has not yet availed.

In contrast, Deaton requires that the customer redeem the coupon as a whole where the coupon expires if not used within a certain period of time (see, Fig. 18C).

The Examiner refers to col. 103, lines 63-65 of Deaton in terms of a time based redeeming, which describes that "a store may offer an incentive to come back again in the next seven day period and if the customer does, the store gives \$2 off the shopping visit." In other words, the measure described in the above col. 103, lines 63-65 is directed to giving an incentive to a user in terms of frequency of visiting a store by the user. Therefore, Deaton does not mention any measure of decreasing the cumulative issued points in proportion to the time used for receiving the electronic information service as in the present invention.

In addition, as acknowledged by the Examiner, Deaton does not teach or suggest an "electronic information service". Therefore, the idea of decreasing the cumulative issued points in relation to the used time cannot exist in Deaton.

As mentioned above, the claimed invention patentably distinguishes over Deaton. Further, as Humble merely discusses a system for in-store marketing that conveys marketing messages to consumers and receiving input from consumers (Fig. 1), Humble does not cure the deficiencies of Deaton regarding the claims of the present application.

Further, even assuming arguendo that Humble does disclose the features discussed by the Examiner, the Applicants respectfully submit that there has been no rationale for combining the cited references. The Examiner stated that the combination of the references would be obvious because the modification would provide visual representation.

Absent hindsight, the record fails to provide the required evidence of a motivation for a person of ordinary skill in the art to perform such modification. While Humble may provide a reason for deploying marketing messages to stores, Deaton fails to suggest why a person of ordinary skill in the art at the time of the invention would be motivated to incorporate displaying in-store marketing messages such as discussed in Humble.

The Examiner maintains that it is old and well known in the computer related arts to provide services electronically in order to avoid the need for the customer to have to wait for the goods or services, or having to pick up the same from a remote location. Essentially, the Examiner makes a conclusion that it is old and well known, at the time of the invention, to provide services electronically such as claimed in the present application. Applicants respectfully traverse the Examiner's statement because supporting evidence related to the claimed functionality has not been provided, and request that the Examiner produce authority for the statement. In particular, Applicants respectfully submit that the claimed invention is not limited to generally providing service(s) electronically.

The Applicants specifically point out the following errors in the Examiner's action.

First, the Examiner uses common knowledge ("well-known") evidence for the rejection. As explained in the M.P.E.P.,

any facts so noticed should... server only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection is based.

M.P.E.P. § 2144.03

Second, the noticed fact is not considered to be common knowledge or well-known in the art. In this case, the limitation is not of notorious character or capable of instant and unquestionable demonstration as being well-known. Instead, this limitation is unique to the present invention (see, M.P.E.P. § 2144.03(A) (the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute").

Third, there is no evidence supporting the Examiner's assertion (see, M.P.E.P. § 2144.03(B) ("there must be some form of evidence in the record to support an assertion of

common knowledge").

Fourth, the Examiner appears to be basing the rejections, at least in part, on personal knowledge. The Examiner is required under 37 C.F.R. § 1.104(d)(2) to support such assertion with an affidavit when called for by the Applicant. The Examiner is called upon to support such assertion.

Further, even if the Examiner's assertion and rejection based on common knowledge is valid, the claimed invention is distinguishable as discussed above.

Therefore, withdrawal of the rejection is respectfully requested.

**CONCLUSION:**

There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: November 17, 2008

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<b>REPLY/AMENDMENT FEE TRANSMITTAL</b>		Attorney Docket No.	122.1046CD2
		Application Number	10/603,832
		Filing Date	June 26, 2003
		First Named Inventor	Tokimori TOMITA, et al.
		Group Art Unit	3622
AMOUNT ENCLOSED	\$130.00	Examiner Name	Raquel Alvarez

**FEE CALCULATION (fees effective 10/02/08)**

CLAIMS AS AMENDED	Claims Remaining After Amendment	Highest Number Previously Paid For	Number Extra	Rate	Calculations
TOTAL CLAIMS	5	- 20 =	0	X \$ 52.00 =	\$ 0.00
INDEPENDENT CLAIMS	5	- 5 =	0	X \$ 220.00 =	\$ 0.00
Since an Official Action set an <u>original</u> due date of <u>October 15, 2008</u> , petition is hereby made for an extension to cover the date this reply is filed for which the requisite fee is enclosed (1 month (\$130));(2 months (\$490));(3 months (\$1,110));(4 months (\$1,730));					\$ 130.00
If Notice of Appeal is enclosed, add (\$540.00)					
If Statutory Disclaimer under Rule 20(d) is enclosed, add fee (\$140.00)					
Information Disclosure Statement (Rule 1.17(p)) (\$180.00)					
Total of above Calculations =					\$ 130.00
Reduction by 50% for filing by small entity (37 CFR 1.9, 1.27 & 1.28)					
<b>TOTAL FEES DUE =</b>					<b>\$ 130.00</b>

(1) If entry (1) is less than entry (2), entry (3) is "0".

(2) If entry (2) is less than 20, change entry (2) to "20".

(4) If entry (4) is less than entry (5), entry (6) is "0".

(5) If entry (5) is less than 3, change entry (5) to "3".

**METHOD OF PAYMENT**

- ☐ Check enclosed as payment.
- ☒ Charge "TOTAL FEES DUE" to the Deposit Account No. below.
- ☐ No payment is enclosed.

**GENERAL AUTHORIZATION**

- ☒ If the above-noted "AMOUNT ENCLOSED" is not correct, the Commissioner is hereby authorized to credit any overpayment or charge any additional fees necessary to:
- |                      |                    |
|----------------------|--------------------|
| Deposit Account No.  | 19-3935            |
| Deposit Account Name | STAAS & HALSEY LLP |
- ☒ The Commissioner is also authorized to credit any overpayments or charge any additional fees required under 37 CFR 1.16 (filing fees) or 37 CFR 1.17 (processing fees) during the prosecution of this application, including any related application(s) claiming benefit hereof pursuant to 35 USC § 120 (e.g., continuations/divisionals/CIPs under 37 CFR 1.53(b) and/or continuations/divisionals/CPAs under 37 CFR 1.53(d)) to maintain pendency hereof or of any such related application.

SUBMITTED BY: STAAS &amp; HALSEY LLP

Typed Name	Temnit Afework	Reg. No.	58,202
Signature	/Temnit Afework/	Date	November 17, 2008